

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Gero Offer
Appl. No.: 09/899,435
Conf. No.: 3369
Filed: July 5, 2001
Title: TELECOMMUNICATION NETWORK, METHOD OF OPERATING SAME,
AND TERMINAL APPARATUS THEREIN
Art Unit: 2153
Examiner: Philip J. Chea
Docket No.: 112740-257

Commissioner for Patents
P.O. Box 1450
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APPELLANTS' REPLY BRIEF

Sir:

I. INTRODUCTION

Appellants submit Appellants' Reply Brief in response to the Examiner's Answer dated January 4, 2007 pursuant to 37 C.F.R. § 41.41(a). Appellants respectfully submit the Examiner's Answer has failed to remedy the deficiencies with respect to the Final Office Action dated February 22, 2006 as noted in Appellants' Appeal Brief filed on October 12, 2006 for at least the reasons set forth below. Accordingly, Appellants respectfully request that the rejections of pending Claims 1-25 be reversed.

II. REGARDING CLAIMS 1 AND 21, A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN ESTABLISHED WITH RESPECT TO THE COMBINATION OF KOBATA AND NAKAGAWA

a. One having ordinary skill in the art would not be motivated to combine *Kobata* with *Nakagawa* in the manner suggested in the Final Office Action to arrive at the present claims

Appellants respectfully request that the Board reverse the section 103 rejections because the Examiner has still failed to provide sufficient motivation or suggestion for one having ordinary skill in the art to combine the cited references to arrive at the present claims without using hindsight. Moreover, Appellants respectfully submit that the Examiner has failed to consider the references as a whole and those portions teaching away from the combination. Instead, it is respectfully submitted that the Examiner has improperly attempted to combine references that have different intended purposes and modes of operation.

As argued previously, the entire disclosure of *Kobata* is directed to a “market delivery system,” which is essentially advertisement delivery software that delivers advertisements or other “targeted” data from a server to users based on information and demographics collected from those users (col. 4, lines 22-25). *Kobata* discloses a system where software is first provided to each user in the network, and each user must execute - and permit - the software to transmit information about their computers and/or their software to the provider 10 (col. 3, lines 52-60; col. 4, lines 43-56; see claim 1: “when the client system executes the software”). The provider then receives an aggregate of information regarding various users’ hardware and software physically residing on their computers (col. 4, line 57 – col. 5, line 5). Having this information, the provider can then tailor advertisements directed to users, and send advertisements that would be optimized by the software residing on a user’s computer (e.g., PDF vs. MPEG), as well as the hardware residing therein (e.g., sound cards, video cards) (see col. 5, lines 1-5, 18-21). The configuration in *Kobata* is clearly disclosed as a “push” system, where, once a user has subscribed to the advertising service and the information from the users is initially received, the advertisements will begin to flow to the users from the server without further interaction (col. 5, lines 6-18, 33-37). Like most every “push” system, such transmissions are transparent to the user, and are intended to be used with minimal interaction (col. 4, lines 43-49).

Along a completely different line of software networking, *Nakagawa* teaches a system and method where an application program on a user's computer detects when software subject to maintenance is activated and transmits an inquiry over the network to the software vendor's computer for information on the current version of the software. The server program compares data in the inquiry with data relating to the latest version of the software and returns update instruction information and updated software if appropriate (see Abstract). Thus, while the software and hardware information concerning a user's computer is initially sent to the software provider, the subsequent updates are premised only upon the software version residing on a user's computer (col. 1, lines 13-19; col. 8, lines 26-36. *Nakagawa* further teaches an "access qualification level" for customers (col. 67, lines 50-60) where customers are offered various functionalities, based on their qualification level. Each qualification level assigned by the seller to the software allows users, depending on their qualification, to access different software at different levels of access (payment type, time of payment, etc. – col. 7, lines 39-48).

It is apparent to Applicant that there is no teaching suggestion or motivation for one having ordinary skill in the art to combine *Kobata* with *Nakagawa*. As discussed above, *Kobata* is a system in which advertisements are targeted to users that choose to volunteer their PC hardware and software information so that an optimal advertising campaign can be formulated for them by advertisers – no software is being "updated". Furthermore, the "push" configuration makes it so that users transparently receive advertisements. Applicant submits *Kobata* teaches away from the presently claimed features, and further teaches away from *Nakagawa*. It is not understood why an interactive control would be implemented in *Kobata* to specify a "charging mode" mode for the downloaded advertisements. To suggest that users in *Kobata* would interactively pay the advertiser to receive advertisements misinterprets the teaching in the reference and of "push" systems in general, and runs contrary to common sense.

Regarding the supplementary evidence provided by the examiner, Applicant notes that the reference cited (US 4,540,585, titled "Food products containing .alpha.-amylase and process") does not appear to have any relation to networked advertisements. Regarding the purported disclosure in the supplementary "Adsenger" evidence, the Examiner's Answer does not explain how the scenario where a user is paid to view advertisements is relevant to the disclosure in *Kobata*. In addition to the arguments provided above, *Kobata* is clear the

advertisements are created to avoid having the user interact with the advertisements by creating a permission list prior to the sending of the advertisements (see, e.g., col. 3, lines 20-27; col. 4, lines 37-55; col. 5, lines 6-17). Moreover, the claims recite the feature of “specifying a charging mode for at least one of downloaded software and downloaded data.” The context of the word “charging” when considering the claim as a whole (where the central server is affiliated with an “access or service provider”) would mean that the owner of a server would require a sum of money from the user for downloading the software/data, and not the reverse.

Also, the access qualification in *Nakagawa* goes to upgrading and purchasing software on a networked user system so that buyers and sellers may effectively negotiate these transactions. In *Kobata*, there is no software to “upgrade,” but only content that is provided to the users (col. 4, lines 22-25, 34-42). Similarly, it is not understood how incorporating the access levels of *Nakagawa*, which restricts user access to software, would be feasible in the advertising-model system of *Kobata*. Again, it wouldn’t make sense to have advertisers create restrictions to their own advertisements on putative consumers. Because of at least these differences, Appellants respectfully submit that the Examiner has failed to provide a sufficient basis or motivation for combining the cited references. Consequently, in view of the portions of the cited references teaching away each other and from the present claims, one having ordinary skill in the art would not be motivated to modify or combine the cited references to arrive at the present claims.

- b. *Kobata* and *Nakagawa*, alone or in combination, fail to disclose or suggest all of the recited feature of claim 1

Appellants respectfully maintain that, even if combinable, the cited references do not disclose or suggest all of the claimed elements. For example, claim 1 recites “a central server having an interrogation part for interrogating hardware and software configurations of a plurality of terminal devices” where the terminal devices have “a response transmitting part for transmitting a configuration code identifying the respective hardware and software configuration to the central server in response to an inquiry by the interrogation part.”

Kobata discloses a client software package (64) that is first installed at a client’s computer. The client then subsequently executes the software, whereupon the software transmits the client’s software/hardware configuration (col. 4, lines 57-67). Thus, the corresponding data

transfer is initiated solely on the client's side (col. 3, lines 6-9, 52-60), and cannot be considered a result of an "interrogation," either in the technical or conventional sense. There is no "response" being initiated by the client. Moreover, the response is not in the form of a configuration code, as recited in the present claims.

Nakagawa discloses a client sending information about a software version in response to a query, however, *Nakagawa* does not disclose a software and hardware configuration being transmitted, and also does not disclose a configuration code.

Also, claim 1 recites that the interrogation part and the response transmitting part interrogate the hardware and software configuration and transmit the respective configuration code when at least one of the terminal device (1) logs onto the telecommunication network, (2) predetermined times occur, and (3) predetermined time intervals occur. *Kobata* clearly fails to teach this configuration.

Moreover, claim 1 recites distributed control parts, which are distributed in both the central server and the plurality of terminal devices, where the distributed control parts implement an interactive control over the software transmitting part, and specifying a charging mode for at least one of downloaded software and downloaded data. As discussed above, *Kobata* does not have any control parts distributed to implement interactive control for charging modes. Regarding *Nakagawa*, the reference teaches that the client's program directs a query to a software provider's server over a network (col. 1, lines 13-19; col. 8, lines 26-36). The "access qualification level" disclosed in *Nakagawa* only refers to control being implemented on the server side only (col. 67, lines 50-60). In other words, the access qualification levels in *Nakagawa* are a indicator of user rights that are defined by the seller on the server, as opposed to the server and the terminal devices – interactive control of the software transmission is controlled on the server side exclusively (see also col. 67, lines 39-48).

As shown above, the cited references fail to disclose or suggest unique aspects of the present claims. Though one may argue that each piece is an independent element, each element is necessary and makes this inventive aspect unique. Consequently, the above-cited references fail to disclose or suggest while teaching away from the above unique aspects of the present claims. As a result, Appellants have met the burden of proof to show that *Kobata* and *Nakagawa* fail to render obvious the present claims. Appellants respectfully submit that the Examiner has improperly applied hindsight reasoning by selectively piecing together teachings of each of the

references in an attempt to recreate what the claimed invention discloses. Accordingly, Appellants respectfully submit that Claims 1-14 are novel, nonobvious and distinguishable from the cited references and are in condition for allowance.

III. REGARDING INDEPENDENT CLAIM 15, A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN ESTABLISHED WITH RESPECT TO THE COMBINATION OF KOBATA, SHAH AND NAKAGAWA

- a. One having ordinary skill in the art would not be motivated to combine *Kobata* with *Shah* and *Nakagawa* in the manner suggested in the Final Office Action to arrive at the present claims

For the same reasons recited above in connection with claim 1, there is no teaching, suggestion or motivation for one having ordinary skill in the art to combine these reference in the manner suggested in the Office Action. With regard to *Shah*, an interactive menu is provided for users that wish to accept or reject features available for a base station in a mobile telecommunication network (col. 9, lines 54-61). However, the Office Action doesn't reconcile how the signaling and network considerations for an interactive menu on the wireless network of *Shah* (i.e., paging channel/access channel) would be incorporated into the line-based system of *Kobata*. Under *Shah*, when a mobile user visits a network, registration procedures are used to enable the visited network to identify the mobile unit network connection and paging purposes, and the mobile station's home network, for billing purposes. Once registered, the base station will download information to the mobile station which will notify the mobile station of which network features are available and how they may be accessed in the local network (col. 3, lines 31-40). However none of the system requirements of *Shah* – i.e., home location registers, base stations, mobile registration, etc. – is remotely applicable to the teaching of *Kobata*. Furthermore, as in *Nakagawa*, it is not explained how or why an interactive menu would be needed for the “push” system of *Kobata*. Again, Appellant respectfully submits this rejection, as in claim 1, was formulated through the use of impermissible hindsight, and without considering each reference as a whole when applying it to the presently claimed features.

b. *Kobata, Shah and Nakagawa, alone or in combination, fail to disclose or suggest all of the recited feature of claim 15*

For the same reasons recited above in connection with claim 1, *Kobata, Shah* and *Nakagawa* fail to teach or suggest the recited features of claim 15. Accordingly, Appellants have met the burden of proof to show that *Kobata, Shah* and *Nakagawa* fail to render obvious the present claims. Appellants respectfully submit that the Examiner has also improperly applied hindsight reasoning by selectively piecing together teachings of each of the references in an attempt to recreate what the claimed invention discloses. As such, Appellants respectfully submit that independent claim 15, and dependent claims 16-25 are novel, nonobvious and distinguishable from the cited references and are in condition for allowance.

V. CONCLUSION

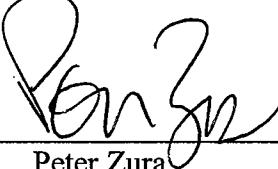
For the foregoing reasons, Appellants respectfully submit that the Examiner's Answer does not remedy the deficiencies noted in Appellants' Appeal Brief with respect to the Final Office Action. Appellants respectfully submit that the Patent Office has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) with respect to the rejections of Claims 1-25. Accordingly, Appellants respectfully submit that the obviousness rejections are erroneous in law and in fact and should therefore be reversed by this Board.

No fee is due in connection with this Reply Brief. The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112740-257 on the account statement.

Respectfully submitted,

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Dated: March 5, 2007